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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/222,554	12/29/1998	VORA V. SANJAY	2207/5939	3007
7590 JOHN C. ALTMILLER KENYON & KENYON 1500 K Street NW Suite 700 WASHINGTON, DC 20005			EXAMINER HUYNH, CONG LAC T	
			ART UNIT 2178	PAPER NUMBER
			MAIL DATE 04/07/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/222,554

Applicant(s)

SANJAY ET AL.

Examiner

Cong-Lac Huynh

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 13-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-9, 13-15, 17-19 and 21-25 is/are allowed.
- 6) ☒ Claim(s) 1-2, 16, 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-884)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. This action is responsive to communications: appeal brief filed on 1/16/08 to the application filed on 12/29/98.
2. Claims 1-9, 13-25 are pending in the case. Claims 1-3, 16, 20-22, 25 are independent claims.
3. In view of the appeal brief filed on 2/6/06, PROSECUTION IS HEREBY REOPENED. A new ground of rejection set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Stephen S. Hong/

Supervisory Patent Examiner, Art Unit 2178

Claim Objections

4. Claim 16 is objected to because of the following informalities: the phrase "at least one of a component" is not proper. Appropriate correction is required.

Double Patenting

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claim 2 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 3. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper et al. (US Pat No. 6,101,503, 8/8/00, filed 3/2/98) in view of Ballard (US 6,182,050, 1/30/01, filed 5/28/08).

Regarding independent claim 1, Ballard discloses automatically selecting an advertisement as a function of an affinity ranking data (col 2, lines 11-64, col 3, lines 40-67).

Ballard does not disclose automatically determining a content data of the given information unit by searching the given information unit, indexing the given information unit to produce indexed data, and performing a relevancy ranking on the indexed data.

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Cooper discloses:

- automatically determining a content data of the given information unit by searching the given information unit, indexing the given information unit to produce indexed data, and performing a relevancy ranking on the indexed data (col 1, lines 13-28: "... First, the data to be searched must be input to the search system for indexing. Next, attributes and/or content are extracted from the objects and processed to create an index. An index consists of data that is used by the search system to process queries and identify relevant objects....The search system processes the query using the index data for the database and a suitable similarity ranking algorithm, and returns a hit-list of topically relevant objects. The user then select relevant objects from the hit-list for viewing and processing."; it is noted that the data is hypermedia data, which includes the web pages)

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Cooper into Ballard for replacing the ranked affinity data of Ballard with the ranked indexed web page data of Cooper. Selecting an advertisement, which is equivalent to a chosen information unit, using the ranked affinity data suggests that selecting an advertisement can be performed on a ranking data. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Ballard into Cooper to use the ranking data in Cooper in selecting an advertisement, which is a chosen information unit, as a function of the relevancy ranking on the indexed data of Cooper instead of the affinity ranking in

Ballard. Such combination of Cooper into Ballard would render the most relevant advertisement data associated with the most relevant web page ranked in a hit-list to a user.

Independent claim 20 is for a storage medium of method claim 1, and is rejected under the same rationale.

10. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Skopp et al. (US Pat No. 6,256,739, 7/3/01, filed 11/26/97).

Regarding independent claim 16, Skopp discloses:

- automatically determining a user computer system data (col 5, lines 26-35: a web page, which is a user computer system data, is determined to select to be associated with a selected advertisement)
- selecting a chosen information unit as a function of the user computer system data (col 1, lines 32-42; col 2, lines 60 to col 3, lines 1-18; figure 3, #320-#340 selecting a related advertisement to incorporate to a web page)

Skopp does not disclose explicitly that said determining is performed by running a diagnostic program on the user computer system to determine at least one of a component coupled in said computer system and a software program loaded on said user computer system.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Skopp to incorporate said determining step since recognizing a component coupled to the computer system using a program was well

known feature in computer environment. Such combination of a diagnostic program into Skopp would recognize quickly a component coupled to the computer system and accordingly quickly determining data included in the recognized component.

Allowable Subject Matter

11. Claims 3-9, 13-15, 17-19, 21-25 are allowed.
12. The following is a statement of reasons for the indication of allowable subject matter: linking the given information unit as a function of automatically comparing the ranked indexed data of the given information unit to the determined content data of a candidate information unit was not disclosed in the prior art of record.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The prior art of record is listed on PTO 892.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Thurs (8:30-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Cong-Lac Huynh/
Primary Examiner, Art Unit 2178
03/28/08